



PATENT

Attorney Docket No:
033082 M 083

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Yutaka TAKAHASHI, et al.

Serial No. : 09/864,374 Art Unit : 1762

Filed : May 25, 2001 Examiner : J. LUND

For : Method for Forming Oxynitride Film or The Like and System for
Carrying Out The Same

#7
6/10/03
mw

RESPONSE TO SECOND WRITTEN RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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TC 1700

Sir:

A response to the Office Action dated May 19, 2003 (Paper No. 6) is due on June 19, 2003. Therefore, please accept this response as timely filed.

In response to the second Restriction Requirement, as set forth in Paper No. 6, Applicants hereby elect the following group:

Group IV, claims 13-17.

However, Applicants respectfully request that the claims of Group II (claims 4-7) and Group VI (claims 21-25 and 28-31) be re-joined and examined with the claims of Group IV. Applicants have proceeded with the understanding that the claims of these three (new) Groups were deemed to all belong to a single group (Group II of claims 4-7, 13-17, 21-25, and 25-31) in the previous Restriction Requirement dated February 12, 2003 (Paper No. 4). Applicants are surprised and disappointed by receipt of another Restriction Requirement rather than a first action on the merits.

A search for the claims in Groups II and VI would not be substantially burdensome after a search for the claims in Group IV because all the claims in these three Groups involve film forming systems. A search for the subject matter of Group IV is inextricably intertwined with the subject matter of the claims of Groups II and VI. Any search for the claims in Group IV will necessarily yield pertinent art for consideration and examination of the claims in Groups II and VI. Hence any necessary extension of the search required for Group IV to the claims of Groups II and VI would not be overly burdensome. See MPEP 804.

Accordingly, the basis for Restriction is not adequately established because a search for the claims of Groups II and VI will not be burdensome after the search for the claims of Group IV has been completed. On the other hand, maintaining this Restriction Requirement will impose undue expense on Applicants in prosecuting multiple applications, otherwise examinable together according to U.S. PTO Patent Examining Procedure. In addition, maintaining this Restriction Requirement may result in undue delay in issue of some claims in this Application, resulting in a significant loss in Patent Term to Applicants. Indeed, prosecution of all the pending claims already has been delayed to some extent by the issuance of another Restriction Requirement rather than a first action on the merits for the previously-elected claims.


For these reasons, reconsideration and rejoinder of the Group II and Group VI claims with the Group IV claims are respectfully requested prior to examination on the merits. This Election is made with traverse, and solely for compliance under 37 CFR § 1.143 in order to preserve pendency in this application.

If any additional fees are due in connection with the filing of this Response, such as fees under 37 C.F.R. §§ 1.16 or 1.17, the Commissioner is authorized to charge SGR Deposit Account No. 02-4300; Order No. 033082.083. Similarly, please credit any overpayment to SGR Deposit Account No. 02-4300; Order No. 033082.083.

Respectfully submitted,

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MAM/BLN